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| SCULLY SCOTT MURPHY & PRESSER, PC | | | BROOKS, MATTHEW L | |
| 400 GARDEN CITY PLAZA | | | ART UNIT | PAPER NUMBER |
| SUITE 300 | | | 3629 | |
| GARDEN CITY, NY 11530 | | | | |

DATE MAILED: 08/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|-------------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/796,345 | KRISHNAMOORTHY, SRIDHAR | |
| | Examiner Matthew L. Brooks | Art Unit 3629 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 16 June 2005.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-19 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-19 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 09 March 2004 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "...providing the user with access to the database, whereby said access provides the user with a virtual office to enter a variety of transactions using data elements in the database." must be shown in FIG. 1 or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. **Claim 19** is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Examiner has thoroughly re-examined the specification and previous claims and finds no support for Claim 19. Emphasis on "...(i) previous repair and customer information as a service call is received and (ii) **a view of recommended solutions related to a problem**, and said dealer/franchisee uses said access to enter technical and billing information and to pass on field information to OEM department." However for purposes of Examination Examiner interprets the claim simply as when a user logs on (whomever the user ie; service department, design...etc.) the information on the site flows to the user and customer history is available to the user and can use this information and the suggested solutions to enter billing information which may then be accessed by OEM.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1-18** are rejected under 35 U.S.C. 102(b) as being disclosed by Non-Patent Literature: Web-site www.shopcollins.com as seen on the "Way back Machine" with an archive date of February 2, 2003; a print out of which is herein attached and shall be referred to as "Collins".

3. With respect to **Claim 1**: Collins discloses
providing equipment service data, (See Page 1, footnote (fn) 1, 2, 5, 6, 7)
creating a database containing a plurality of equipment service data elements;
(See Page 1, fn 1, 2, 5, 6, 7). Inherently, Collins must have a database in order for a "user" to "obtain catalog data for Rockwell" or "Obtain pricing information for Service Parts, Training, and Technical Publications" (see fn 5).

providing an access point for a user to access the database; Inherently, Collins provided an access point, because it was on the world wide web (See Pages 1-3)
verifying that the user is authorized to access the database (See Page 1, fn 4, 6 and 9; and Page 3, fn 10); and

providing the user with access to the database over a secure network if the user is authorized to access the database (See Page 1, fn 4, 6 and 9; and Page 3, fn 10),
whereby said access provides the user with a virtual office to enter a variety of transactions using data elements in the database (See Page 1, fn 6 wherein Examiner considers a "virtual office" to be a place on the web that allows a user to do work; transactions include "order service parts" and "Purchase selected Technical Publications").

4. With respect to **Claim 2**: Collins discloses

wherein the plurality of equipment service data elements comprise data elements regarding at least one of: sales, customer history, equipment history, warranties, service calls, preventive maintenance, repairs, spare parts, accounts receivable, and accounts payable. (See Pages 1 and 3, fn's 1-10) Collins shows that users can "Obtain order and shipping status for any orders placed..." therefore inherently it must keep a customer history.

5. With respect to **Claim 3**: Collins discloses

wherein the user comprises at least one of: a customer, a potential customer, and a franchisee (See Page 1).

6. With respect to **Claim 4**: Collins discloses

wherein the access point is an Internet web site (See Pages 1-3, which was retrieved from the web).

7. With respect to **Claim 5**: Collins discloses

wherein the database is created by a manufacturer of a product, and wherein the user is a service provider authorized by the manufacturer to service the product (See Pages 1-3, which are a print out of a web page created by the manufacturer of a product). Examiner also points to **Page 1, fn 8**; wherein Rockwell Collins explicitly authorizes a service provider to service the products and inherently the service provider must be a user.

8. With respect to **Claim 6**: Collins discloses

wherein the service data elements relate to at least one of: selling maintenance contracts, call management, franchisee management, spare parts sales, warranty management, and knowledge management (See Page 1, fn's 5-8). Examiner considers service parts to be spares and knowledge management to be anything dealing with knowledge of said customer.

9. With respect to **Claims 7 and 13**: Collins discloses
 - providing equipment service data, (See Page 1, footnote (fn) 1, 2, 5, 6, 7)
 - creating a database containing a plurality of equipment service data elements; (See Page 1, fn 1, 2, 5, 6, 7). Inherently, Collins must have a database in order for a "user" to "obtain catalog data for Rockwell" or "Obtain pricing information for Service Parts, Training, and Technical Publications" (see fn 5).
 - providing an access point for a user to access the database; Inherently, Collins provided an access point, because it was on the world wide web (See Pages 1-3)
 - verifying that the user is authorized to access the database (See Page 1, fn 4, 6 and 9; and Page 3, fn 10); and
 - providing the user with access to the database over a secure network if the user is authorized to access the database (See Page 1, fn 4, 6 and 9; and Page 3, fn 10),
whereby said access provides the user with a virtual office to enter a variety of transactions using data elements in the database (See Page 1, fn 6 wherein Examiner considers a "virtual office" to be a place on the web that allows a user to do work; transactions include "order service parts" and "Purchase selected Technical Publications")..

10. With respect to **Claims 8 and 14**: Collins discloses
wherein the plurality of equipment service data elements comprise data elements
regarding at least one of: sales, customer history, equipment history, warranties, service
calls, preventive maintenance, repairs, spare parts, accounts receivable, and accounts
payable. (See Pages 1 and 3, fn's 1-10) Collins shows that users can "Obtain order
and shipping status for any orders placed..." therefore inherently it must keep a
customer history. However, Applicant should note that this is non-functional descriptive
data and the terminology used in Applicant's claim is not afforded much weight.
11. With respect to **Claims 9 and 15**: Collins discloses
wherein the user comprises at least one of: a customer, a potential customer,
and a franchisee (See Page 1). Applicant should note that although Collins does
disclose that the user is at least a customer or potential customer, it is irrelevant
because the terms are simply a matter of terminology.
12. With respect to **Claims 10 and 16**: Collins discloses
wherein the access point is an Internet web site (See Pages 1-3, which was
retrieved from the web).
13. With respect to **Claims 11 and 17**: Collins discloses
wherein the database is created by a manufacturer of a product, and wherein the
user is a service provider authorized by the manufacturer to service the product (See
Pages 1-3, which are a print out of a web page created by the manufacturer of a
product). Examiner also points to **Page 1, fn 8**; wherein Rockwell Collins explicitly
authorizes a service provider to service the products and inherently the service provider

must be a user. Applicant should note that although Collins does disclose that the user is a service provider, it is irrelevant because the terms are simply a matter of terminology.

14. With respect to Claims 12 and 18 Collins discloses wherein the service data elements relate to at least one of: selling maintenance contracts, call management, franchisee management, spare parts sales, warranty management, and knowledge management (See Page 1, fn's 5-8). Examiner considers service parts to be spares and knowledge management to be anything dealing with knowledge of said customer. However, Applicant should note that this is just data and the terms given to the data is simply non-functional descriptive matter.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

17. **Claim 19** is rejected under 35 U.S.C. 103(a) as being unpatentable over "Collins" in view of Official Notice.

Collins shows all of the limitations as described in claim 1 and also shows that the website is a "database and communications resource which is intended to improve the operational reliability of their products" (See page 3, fn 10). Because this is a database in which secure access is required, whomever has access and site is accessed allows the information to flow. Collins shows numbers to call for service calls (fn 7) and inherently their own employees have access to this database and anyone who is given the password would allow the field information collected to pass on to any user (OEM or otherwise).

Collins does not show, *per se*, whom the exact users would be that would have access to the information collected on the web site and the database thereof.

However, in view of Official Notice that it is old and well known to allow service departments, design departments and quality departments access to information obtained from the field so the data may be used to better design and improve products quality and increase customer satisfaction. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Collins to allow the design department and quality departments or any other department some type of access to information obtained on the field in order to effectively use the information to improve products and services.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A. Pub. No.: US 2002/0016655 A1 (Joao) Which shows a service provider [0018] hosted website [0026] which requires authorized access [0027] and a vast array of services [0028] with a comprehensive data base of the offered product [0029] and an array of training [0030] with the ability to diagnose the problem [0033] and the customer histories including repairs [0034] with the possibility of obtaining data directly from the product.

B. Patent Number 6,003,078 (Kodimer et al).

C. EP 0 822 473 A2 30.07.1997 (Ogushi)

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Response to Arguments

20. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies for instance: A-O are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Examples include found with in the REMARKS:

- A. Page 12, 3rd Paragraph wherein Applicant states "creating a database containing a plurality of service data element has a larger meaning. Applicant is advised to claim whatever meaning intended.
- B. Page 12, 3rd Paragraph the term "User" and to whom the user may or may not include. Examiner turns to Applicant's Specification, Page 5 [0021] wherein "user comprises at least one of: a customer, a potential customer, and a franchisee." NOTE: no mention of any QUALITY, SALES or DESIGN departments is found there or anywhere with in the specification. Furthermore if Applicant now chooses to claim it as such Applicant is advised to do and also point to the specification support for such matter.
- C. Page 12, bottom of page, as to "information flow" Collins definitely shows this and the term is not even found with in the originally filed specification.

D. Page 13, 1st Paragraph “per se not offer training” Examiner respectfully disagrees and points to fn 2 and fn 5 furthermore Applicant is reminded to Claim the differences.

E. Page 13, 2nd Paragraph “the important preferred feature”. Examiner suggests Applicant to claim an embodiment geared towards the preferred embodiment.

F. As to the “record of orders and shipping status” Applicant should claim the inventions scope as they would like, although Examiner respectfully disagrees with Applicant’s position.

G. Page 13, Last Paragraph “Warranty Information” is not readily apparent/found with in the specification. So amend the claims/ and point to Examiner support found with in the specification in order to avoid future new matter 112 1st Paragraph rejections.

H. Page 14, 2nd Paragraph As to “mobile handheld device”; Applicant has not claimed this at all and if Applicant chooses to claim show Examiner support for found with in the specification. But, Applicant should be forewarned “mobile handheld devices” at the time of the invention were old and well known with in the art to access websites and the information contained therein.

I. Page 14, 3rd Paragraph Applicant needs to claim, but Examiner respectfully disagrees with Applicant’s position. Collin’s user may be anybody and is not so limited as Applicant suggests. Also whatever amendments are made which correspond to this argument it is suggested to show Examiner support for in the original filed specification.

J. Page 15, 1st and 2nd Paragraph Applicant needs to claim, but Examiner respectfully disagrees with Applicant’s position. Also whatever amendments are made

which correspond to this argument it is suggested to show Examiner support for in the original filed specification.

K. Page 15, 3rd Paragraph Applicant needs to claim, but Examiner respectfully disagrees with Applicant's position. Also whatever amendments are made which correspond to this argument it is suggested to show Examiner support for in the original filed specification. Furthermore a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

L. Page 16, 1st Paragraph a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

M. Page 16, 3rd Paragraph Applicant needs to claim, but Examiner respectfully disagrees with Applicant's position. Also whatever amendments are made which

correspond to this argument it is suggested to show Examiner support for in the original filed specification.

N. Page 17, 1st Paragraph a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

O. Page 17, 2nd Paragraph “virtual office” Examiner turns to Page 7 [0028] for the definition found with in the specification, which is essentially the same as Examiner’s aforementioned definition, as a virtual office space in the network where a user can perform day to day transactions. Examiner respectfully disagrees that Collins does not show this. For a list of possible transactions see Collins, fn 4-6.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew L. Brooks whose telephone number is (571) 272-8112. The examiner can normally be reached on Monday - Friday; 8 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, John Weiss can be reached on (571) 272-8112. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MLB
8/11/05

gcl
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